

REMARKS

The applicant's remarks are preceded by text from the most recent action in small bold-faced type.

Claims 72,90 are rejected under 35 U. S. C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, in claim 72, it is unclear what processing is performed on the value information sent to the server for storage, therefore, it is seen as non-functional descriptive material and will not be treated on the merits. Further, it is unclear what linkage exists between the commodity and the device, which makes it unclear how the "event based on the user's interaction with the commodity" causes a response to the device from the server or what relationship "in the course of the user's interaction with the commodity" has to the device.

Claim 72 no longer recites both a commodity and a device, and indicates that the solution information is received in response to a problem, thus obviating the Examiner's concerns.

Specifically in claim 90, it is unclear how a device can be software, as a device or apparatus is by its nature hardware, as can be seen in claim 92 in which the device stores a script, such storage would imply a memory, which is hardware.

Claim 90 is cancelled without prejudice.

Claim 102 is rejected under 35 U. S. C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear how the software is executed since no means is clearly recited. Further, it is unclear if the trigger is being monitored at the server or the client.

Claim 102 is amended to address the Examiner's concern. The processor at the server detects the trigger from one of the client systems.

4. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

Although In re Danly, 263 F.2d 844, 848 ("Danly") includes language similar to the passage above, this case does not stand for the broad proposition that the Examiner asserts. Danly was an appeal to the Court of Custom of Patent Appeals (CCPA) from a decision by the

Board of Appeals on a patent application drawn to a power press tie rod heating system. Id. at 844. Although the CCPA affirmed the rejection of claims 1 and 2, the CCPA reversed the rejection of claims 3 through 7. Id. at 847-848. The language at issue in claims 3 through 7 was functional ("means for connecting the ends of the . . . tie rods to a source of alternating current potential"). Although the cited prior art had a similar structure to the apparatus of claim 7, the CCPA found that the functional language, as recited in claim 7 (but not the language of claim 1), was sufficient to distinguish the cited reference. Thus, the holding of Danly does not emasculate functional language in an apparatus claim.

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus " if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (Bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 102, including a server storing information and a client that receives information are disclosed in the Orr reference as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Ex parte Masham ("Masham") is an administrative decision of the Board of Patent Appeals and Interferences and cannot controvert precedent from the CCPA. As discussed above, the CCPA held in Danly that recitation of the manner in which a claimed apparatus is employed (the use of alternating current in claim 7) *does* differentiate the prior art.

Moreover, the application on appeal in Masham concerned a mechanical device, not a computational device. In re Lowry, 32 F.3d 1579 (Fed. Cir. 1994) held that, at least with respect to computational devices, the software and informational features recited in the claim had to be considered in evaluating patentability. The Federal Circuit noted that:

There is one further rationale used by both the board and the examiner, namely, that the provision of new signals to be stored by the computer does not make it a new machine, i.e. it is structurally the same, no matter how new, useful and unobvious the result.... To this question we say that *if a machine is programmed in a certain new and unobvious way, it is physically different* from the machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed.

Id. at 1583 (emphasis added). Thus, the Federal Circuit decision in In re Lowry undermines application of the administrative decision in Masham to the claims of this application. With respect to computational devices, the limitations at issue have patentable weight.

Claims 72, 90-94 are rejected under 35 U. S. C. 102(a) as being anticipated by Orr (Join the Information Economy).

As per Claim 72. Orr discloses: the user records value information on a client device, see abstract, lines 9-11 and text, lines 17-20; the client device sends the information to the server, see abstract, lines 9-13; the client device receives from the server additional value information recorded by other users, in response to an event based on the user's interaction with the commodity, see text lines 17-24; the client device presents the additional information to the user, see text lines 17-24.

Claim 72 has been amended. The passages of Orr cited by the Examiner state, for example, "if customers don't see what they are looking for, they can post a request and take bids." However, Orr does not disclose that the client device receives from the server solution information recorded by other users, in response to a problem arising from the user's interaction with the client device. Thus, Orr cannot anticipate claim 72 and claims dependent therefrom.

6. Claim 102 is rejected under 35 U. S. C. 102(a) as being anticipated by Dyson (Information, bid and Asked), Orr (Join the Information Economy), or Fryxell (Driving a hard bargain). As per Claim 102. Dyson (Information, bid and Asked), Orr (Join the Information Economy), and Fryxell (Driving a hard bargain) disclose: a server storing information and clients receiving information, see abstracts of Dyson and Orr and paragraphs 3-4 of Fryxell.

Claim 102 has been amended. Given the brevity of the Examiner's rejection, the Applicant infers that the Examiner is relying on the Examiner's earlier position (i.e., that the claim language is ineffectual) in paragraph 4 of the office action. The Applicant has traversed that rejection above. Moreover, the cited references do not teach or suggest a system in which the processor distributes information in response to a trigger received from one of the client systems in response to an exception arising from use.

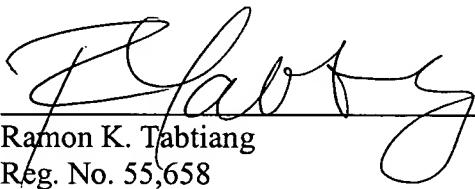
The Applicant respectfully submits that all claims are in condition for allowance, which action is expeditiously requested. Claims 118-129 are new. Some of these new claims relate to a handheld telephone. The Applicant notes that, despite their prevalence, users still encounter problems in using with handheld telephones. Such devices are at least one example of a device whose performance would benefit from the concepts described in this application.

The Applicant does not concede any positions of the Examiner that are not expressly addressed above. All amendments and cancellations are made without prejudice and disclaimer and may be made for reasons not explicitly stated, for example, to alter or broaden scope or to maintain identical scope, but with alternative language.

Enclosed is a \$490 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing attorney docket number 03058-004002.

Respectfully submitted,

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